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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TECH CENTER 1600/290

In re patent application of:
Tor MCPARTLAND

Serial No. 09/706,158

Filed: November 3, 2000

For: ANT SPRAY CONTAINING D-
LIMONENE AND METHODS OF
MAKING AND USING SAME

Group Art Unit: 1617

Examiner: ROBINSON, A.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Box Fee Amendment, Assistant Commissioner for Patents, Washington, D.C. 20231, on August 15, 2002 by Michelle Daugherty *[Signature]*

Response to Office Action Dated February 15, 2002

In response to the Office Action dated February 15, 2002, Applicant makes the following remarks:

1. Section 112 rejections

Claims 1,3, 4, 7-9, 11, 13 and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to set forth relative proportions for all ingredients claimed. Claim 1 recites, "an amount of D-limonene sufficient to provide insect control . . . [and] an amount of a non-toxic emulsifying agent sufficient to solubilize D-limonene in said non-toxic hydrophilic solvent. " Claim 13 includes a similar recitation to that of claim 1. Claims 3, 4, 7-9 and 11 are

dependent on claim 1 and claims 17-19 are dependent on claim 13 and incorporate the quoted language by reference.

The Examiner believes that the these claims are indefinite because they fail to specify the proportions for all ingredients claimed. However, Applicant is not required to specify the amount of the claimed ingredients as a percentage or a proportion. Here, Applicant has specified the amount of D-limonene and emulsifying agent in relation to the function to be achieved. There is nothing indefinite in the use of claim language which defines particular amounts according to a functional criterion. See In re Fuetterer, 50 CCPA 1453, 319 F.2d 259, 138 USPQ 217 (1963); In re Swinehart, 58 CCPA 1027, 439 F.2d 210, 169 USPQ 226 (1971).

In In re Spiller, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974), the Examiner rejected a claim as indefinite for requiring use of starch "in amount sufficient to be capable of causing selective modification of surface properties." The Board affirmed the Examiner's decision. In reversing the Examiner and the Board, the Court of Customs and Patent Appeals held that the claim is not indefinite because "the claims make it clear, through the use of the word 'selective', that any modification of surface properties is subjectively desirable in the particular coating applied." 500 F.2d 1170, 1180-1181, 182 USPQ 614,

622 (CCPA 1974) (Also see, In re Conley, 490 F.2d 972, 180 U.S.P.Q. 454 (1974), wherein the Court dealt with, and reversed, a similar rejection of claims as indefinite for failure to recite specific proportions and amounts of certain ingredients).

Claim 1 and Claim 13 both recite that the amount of D-limonene must be sufficient to provide insect control and the amount of non-toxic emulsifying agent must be sufficient to solubilize the D-limonene in non-toxic hydrophilic solvent. The language of the present application mirrors the language of the subject claims in In re Conley and In re Spiller, which were held to be improperly rejected. Accordingly, Applicant respectfully submits that under the governing case law, the section 112 rejection is improper and should be withdrawn.

Claims 1 and 11 are further rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to differ in scope. Claim 11 is dependent on claim 1 and further limits claim 1 in the type of insect that the composition controls. It is presumed that the Examiner discounts the limitation added by claim 11 because it is directed to the functional language of claim 1, i.e., claim 11 is directed to the composition's "insect control" feature. Because the "insect control" feature defines the composition by what it does rather than what it is, and claim 11 further specifies this function of the composition, it has been

ignored by the Examiner. However, the MPEP requires the functional limitation of a claim to be evaluated and considered like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. Manual of Patent Examining Procedure, section 2173.05(g). In this regard, claims 1 and 11 do not have the same scope because claim 11 specifies the particular types of insects that the composition is capable of controlling, whereas claim 1 only requires the composition to provide "insect control." The rejection is improper and should be withdrawn.

Section 103 rejection

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klopping, in view of Van Tonder, Dotolo, and Wilkins, Jr. The present invention is a novel food-grade composition that kills insects. Claim 1 recites "a food-grade insecticidal composition." Accordingly, all components of the composition must be non-toxic and food-grade. Because of its food-grade quality, the claimed composition can be used anywhere, including on humans, animals, plants, near food, on kitchen table tops and sinks. Prior art insecticides containing D-limonene are irritating to human skin and cannot be used near food preparation areas due to their toxicity. If prior art insecticides are used near

food preparation areas, the area would have to be cleaned and disinfected prior to using the surface for food preparation. Accordingly, there has been a long-felt need to provide a safe insecticide that could be used on the human skin and on food preparation areas.

Dotolo does not disclose a food-grade emulsifying agent, and therefore, does not disclose a food-grade insecticidal composition. Dotolo discloses the combination of Triton X-100, D-limonene and water. Triton X-100 is not a food-grade emulsifier (the Kodak Laboratory Chemical Catalog No. 51 indicates that Triton X-100 is irritating to the skin and eyes). If the Dotolo composition is sprayed on a household surface, the surface must be cleaned and detoxicated thereafter for safety. Accordingly, claim 1 of the application is distinguishable over Dotolo because Dotolo does not disclose a food-grade emulsifying agent. Furthermore, claims 7 and 8 specify castor oil and polyoxyethylenesorbitan as food-grade emulsifying agents. Dotolo also fails to disclose these emulsifying agents. Because of its ingredients, the use of the Dotolo composition is limited to an external application as a dip or a spray. In contrast, the food-grade composition of the present invention can safely be used in the preparation and cultivation of food.

The Examiner states that the claims are obvious in view of Van Tonder and Klopping. Van Tonder is presumably cited because it mentions castor oil. However, nothing in Van Tonder suggests combining the castor oil with D-Limonene. Van Tonder refers to an insecticidal composition for external treatment of domestic and farm animals. Col. 1, lines 7-10 and col. 6, lines 62-68. All of the embodiments described in columns 3 through 5 are for external applications (shampoos, dips, and garden sprays). Nothing in Van Tonder teaches or suggests that the composition is food-grade or that it may be used in preparation or cultivation of food. In fact, components such as "diacetone alcohol" (col. 6, line 1), and "synthetic pyrethroid" would suggest the opposite to those skilled in the insecticide art.

The same may be said of the other reference, Klopping. Klopping does not disclose a combination of D-Limonene with a food-grade emulsifying agent. Klopping is directed to a fungicidal composition for use "on living plants or plant parts." Col. 1, lines 19-22. The active compound, 2-benzimidazole carbamic acid is structurally related to other benzimidazole compounds that are known irritants. Klopping does not teach a food-grade insecticide that is non-irritating and safe, even if consumed.

In the Declaration of Tor McPartland, filed in conjunction with the preliminary amendment on December 20, 2000 ("Supp. Decl."), McPartland states that the inventive composition has been accepted by the Organic Material Review Institute ("OMRI") for use in organic production. The OMRI acceptance is significant for several reasons. First, OMRI had to define a new category, "plant extract pesticides," for identification of Applicant's insecticide composition. See Supp. Decl., ¶ 7. The fact that OMRI had to define a new category for Applicant's product evidences the novelty of the product. There were no other plant extract pesticides approved for use in organic production by OMRI prior to Applicant's product. Supp. Decl., ¶ 7. Second, OMRI's acceptance of Applicant's product was significant in that it boosted the sales of Applicant's product. Supp. Decl., ¶ 8. In 1998, prior to OMRI's acceptance, annual sales of Applicant's product were approximately \$39,000. Supp. Decl., ¶ 8. The following year, upon OMRI's approval, the sales increased six-fold, exceeding \$250,000. Supp. Decl., ¶ 8.

The Examiner states that the declaration of Tor McPartland is insufficient to overcome the rejection because the commercial success is not related to the technology of the instant application, but is due to various types of advertising. However, the evidence of record indicates that the significant increase in sales

was not a result of an increase in advertising, as the advertising campaign during 1998 and 1999 remained relatively static. Supp. Decl., ¶ 9. Rather, the commercial success of Applicant's product was a result of Applicant's ability to satisfy a long felt need for an insecticidal composition that is made of food-grade ingredients and can be used in organic production. Supp. Decl., ¶¶ 5, 6, 10 and 11. This finding is consistent with the fact that timing of the six-fold increase in sales coincided with OMRI's acceptance of Applicant's product for use in organic production.

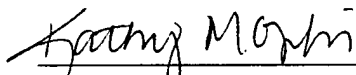
The Examiner states that a declaration showing unexpected and/or unobvious results in a side-by-side comparison of the non-toxic composition of the Dotolo reference vs. applicant's non-toxic composition is needed. Applicant has submitted objective evidence of commercial success, long-felt need, and professional approval. Yet the Examiner remains adamant that a comparison study is required. Any one of these factors is sufficient by itself to overcome an obviousness rejection. Applicant respectfully requests that the Examiner reconsider the evidence of record, as it is more than sufficient to indicate that the claimed invention was not obvious in view of prior art.

In view of the foregoing remarks, it is believed that all pending claims are in condition for allowance. A Notice of allowance is respectfully requested.

Should there be any questions regarding this application, the Examiner is invited to contact the undersigned attorney at the phone number listed below.

Respectfully submitted,

August 15, 2002
Date



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